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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,332	10/17/2003	Gerhard Gumpoltsberger	ZAHFRI P530US	2307

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EXAMINER

HO, HA DINH

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,332

Applicant(s)

GUMPOLTSBERGER ET AL.

Examiner

Ha D. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/07/03 & 1/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first Office Action on the merits of Application No. 10/688,332 filed on 10/17/03. Claims 12-22 are currently pending.

Election/Restrictions

2. Applicant's election without traverse of Species of Figures 1, 2 and 3 in the reply filed on 03/10/05 is acknowledged.
3. During the telephone interview on 05/13/05, Applicant confirms that claims 12-15 and 17-21 are readable on the elected Species.
4. Claims 16 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03/10/05.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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6. The abstract of the disclosure is objected to because its length is less than 50 words.

Correction is required. See MPEP § 608.01(b).

Claim Objections

7. Claims 13 and 14 are objected to because of the following informalities:

- Claim 13, line 1, “a third” should be changed to --the third-- since three auxiliary shafts were recited in claim 12.
- Claim 14, line 3, “a first” should be changed to --the first--.
- Claim 14, line 4, “a second” should be changed to --the second--.
- Claim 14, line 7, “a first” should be changed to --the first--.
- Claim 14, line 8, “a second” should be changed to --the second--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 14, the recitations of “two shift control elements” in lines 2-3, and “a shift control element” in lines 4, 6 and 7-9, constitute double inclusions since “shift control elements” were previously recited in claim 12, line 6. It is suggested to recite first,

second, third or fourth shift control element to refer to the previously recited shift control element.

- Claim 14, the terms “both” in lines 6 and 7 are unclear because the intended antecedent of “both” is unclear.
- Claim 15, the recitations of “spur gear transmission ratios” in line 3, and “a spur gear transmission ratio” in line 4, constitute double inclusions since “spur gear transmission ratios” were previously recited in claim 12, line 5. It is suggested to recite first, second, third or fourth spur gear transmission ratio to refer to the previously recited spur gear transmission ratio.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 12, 13, 15 and 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bosko et al. (3,572,167).

Bosko et al show an automated multiple-gear transmission with an input shaft (34), a gearwheel assembly (gears and clutches/brakes) to engage gears, via several output paths (see Figs. 5-12), an output shaft (30), and an auxiliary three-shaft planetary assembly (20-28), wherein the gearwheel assembly comprises at least four intermediate independent spur gear stages (45, 46, 48, 50, 52, 54, 55, 56), which are formed as spur gear transmission ratios and

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which can be connected to two (22 and 20) of the three auxiliary shafts of the planetary assembly (20-28) directly or via shift control elements (A-J), such that three shift control elements are engaged for each engaged gear (see Figs. 5-12).

Regarding claim 13, wherein the third shaft (26) of the planetary assembly is connected to the output shaft (30).

Regarding claim 15, wherein the planetary assembly is a plus planetary assembly, whose drive takes place at an annular gearwheel (22), such that the spur gear transmission ratios (52, 54) are in active engagement with a solar gearwheel (20), while the spur gear transmission ratio (55) is in active engagement with the solar gearwheel (20).

Regarding claim 17, wherein the shift control elements (A-J) are made as form-locking shift control elements designed as synchromeshes or as claw couplings.

Regarding claim 18, wherein the shift control elements (A-J) are made as frictional change-under-load elements.

Regarding claim 19, wherein the shift control elements (A-J) are arranged before associated spur gear transmission ratios.

Regarding claim 20, wherein the shift control elements (A-J) are arranged after associated spur gear transmission ratios.

Regarding claim 21, wherein the transmission comprises a countershaft (35).

Allowable Subject Matter

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12. Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Cited Prior Art

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kelbel'890, Galicher'202, Nasvytis'119, Smith et al.'483, Numazawa et al.'869, Borodin et al.'142, Shubinsky et al.'471, and Kuribayashi'247 which each shows a transmission including a plurality of spur gear units and a planetary gear.

Communication

14. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are **(703) 872-9306**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)


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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha D. Ho whose telephone number is **571-272-7091**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on **571-272-7095**.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HDH
(703) 305-0738
May 13, 2005


HAHO
PRIMARY EXAMINER
Art Unit 3681 5/13/05